

REMARKS

Status of Claims and Amendment

Upon entry of this amendment, which is respectfully requested, claims 3, 15, 17, 21, and 66-68 will be amended. Claims 2, 4-8, 10-12, 14, 16, 18-20, and 22-24 have been canceled. Claims 1, 3, 9, 13, 15, 17, 21 and 66-69 are all the pending claims being examined in the present application. Claims 25-65 are withdrawn as being drawn to a non-elected invention. Claims 3, 13, and 66-68 are rejected.

Claims 3 and 66-68 have been amended to recite “A vector” and to even further clarify that the culture cells are “*S. pombe* cells.” Support for the amendments to the claims may be found throughout the specification, for instance, at page 4, lines 25-26, Examples, and Figure 7. In addition, claims 3 and 66-68 have been amended to recite “when the *S. pombe* cells are subjected to a temperature shift from 36°C to 25°C” in response to objections to the claims.

Claim 13 has been amended to replace “[a]t least one vector” with “[a] vector”, and replacing “the vector corresponding to Accession No.” with “a vector deposited under Accession No.”, as suggested by the Examiner in response to objections to the claims. In addition, claim 13 has been amended to recite “an isolated promoter” as suggested by the Examiner to overcome a §101 rejection.

Claims 15, 17, and 21 has been amended to recite “further”.

The specification has been amended at the paragraph bridging pages 1-3 to replace “till date” with “to date” as suggested by the Examiner in response to an objection to the specification. In addition, the paragraph at page 26, lines 11-36 of the specification has been deleted to remove the partial sequence listing as suggested by the Examiner in response to an objection to the specification.

No new matter is added.

Applicants thank the Examiner for indicating that claims 1, 9, and 69 are allowable.

Applicants thank the Examiner for withdrawing the rejection to claims 1, 10, and 11 under 35 U.S.C. § 102(b).

Withdrawn New Claims 63-65

At pages 2 to 3 of the Office Action, the Examiner has withdrawn newly added claims 63-65 because the claims were not originally presented.

In response, Applicants note that because the Examiner has indicated that the method claims are related to the elected claims as product and process of use claims, claims 63-65 will be eligible for rejoinder. Accordingly, Applicants respectfully request rejoinder of claims 63-65 upon an indication of the allowability of claims 1 and 13.

Drawings

Applicants thank the Examiner for accepting the Drawings filed January 21, 2005.

Objections to the Specification

The specification is objected to for the following informalities. The Examiner objects to a partial listing from the sequence listing on page 26 of the specification, and suggests deleting the sequence listing for clarity. The Examiner also suggests amending the statement “till date” to “to date” on page 2 line 7.

In response, Applicants have amended the specification to delete the sequence listings for SEQ ID No:1 and SEQ ID No:2 from page 26 of the specification, as suggested by the Examiner.

In addition, Applicants have amended the specification to replace “till date” to “to date” on page 2, line 7 of the specification, as suggested by the Examiner.

Objections To The Claims

The Examiner objects to claims 3, 13 and 66-68. The Examiner suggests amending claim 3 to recite “temperature shift of a culture of cells comprising the promoter” because the Examiner asserts that it is the cells comprising the promoter that are subjected to temperature shift and not the isolated promoter itself. The Examiner suggests the same amendment to claims 66-68.

With regard to claim 13, the Examiner suggests replacing “[a]t least one vector” with “[a] vector” or “[t]he at least one vector.” In addition, the Examiner suggests replacing “the vector corresponding to Accession No.” with “a vector deposited under Accession No.”

In response, Applicants have amended claim 13 as suggested by the Examiner, and amended claims 3 and 66-68 to recite “when the *S. pombe* cells are subjected to a temperature shift from 36°C to 25°C” to even further clarify that cells comprising the promoter are subjected to a temperature shift and not the isolated promoter itself.

Withdrawal of the grounds of objection is respectfully requested.

In addition, the Examiner has indicated that claims 15, 17, and 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

In response, Applicants note that claims 15, 17, and 21 are dependent on claim 13 which has been amended as suggested by the Examiner to overcome the § 101 rejection. Accordingly, withdrawal of the objection to claims 15, 17, and 21 and allowance of claims 15, 17, and 21 is respectfully requested.

Claim Rejections Under 35 U.S.C. § 101

Claim 13 is rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Specifically, the Office Action asserts that the claims do not distinguish over cells that exist naturally because the claims do not particularly point out any non-naturally occurring products. The Office Action suggests amending the claims to recite “isolated” or “purified”.

In response, and solely to advance prosecution of the present application, Applicants have amended claim 13 as suggested by the Office Action.

Withdrawal of the rejection under § 101 is respectfully requested.

Claim Rejections Under 35 U.S.C. § 112

Claims 3 and 66-68 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement, for the same reasons of record.

Specifically, the Office Action states that the specification is enabling for maximum expression of GFP, β -galactosidase, cdc18 or streptokinase within 3 hours of a temperature shift from 36°C to 25°C in the absence of thiamine, wherein expression is in *S. pombe* cells transformed with constructs comprising SEQ ID NO:1 or SEQ ID NO:2 operably linked to sequences coding for GFP, β -galactosidase, cdc18 or streptokinase. However, the Office Action asserts that the specification does not enable any other embodiment.

In addition, it appears the Office Action is not persuaded by Applicants’ arguments because the Office Action asserts that Applicants have not shown that maximum expression is induced in any other host cell than *S. pombe*.

In response, and solely to advance prosecution of the present application, claims 3, and 66-68 have been amended to recite that the host cell is *S. pombe*.

Withdrawal of the rejection under § 112, first paragraph, is respectfully requested.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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